

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

AF  
JFW

In re the Application of

Ola OLOFSSON et al

Serial No.: 09/910,960

Filed: July 24, 2001

For: GUIDING MEANS AT A JOINT



Confirmation No.: 4841

Group Art Unit: 3679

Examiner: V. MacArthur

**RESPONSE TO NOTICE OF NON-COMPLIANT APPEAL BRIEF**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, Virginia 22313-1450

Dear Sir:

Responsive to the Office Action mailed December 4, 2006, applicants submit herewith an Appeal Brief which complies with the provisions of 37 CFR § 41.37.

As the fee for the filing of the Appeal Brief was previously paid on September 25, 2006, no additional fee should be necessary. However, if any additional fee is necessary, it may be charged to the undersigned's deposit account number 19-4375.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Thomas P. Pavelko".

Thomas P. Pavelko  
Registration No. 31,689

TPP/mat  
Attorney Docket No.: TPP 30887CIP2

STEVENS, DAVIS, MILLER & MOSHER, L.L.P.  
1615 L Street, N.W., Suite 850  
Washington, D.C. 20036  
Telephone: (202) 785-0100  
Facsimile: (202) 785-0200

Date: January 4, 2007

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
Before the Board of Patent Appeals and Interferences



In re the Application of

Ola Olofsson et al.

Group Art Unit:

3679

Serial No.: 09/910,960

Examiner:

V. MacArthur

Filed: July 24, 2001

Confirmation No.:

4841

For: GUIDING MEANS AT A JOINT

**APPEAL BRIEF**

Thomas P. Pavelko, Esquire  
Registration No.: 31,689  
STEVENS DAVIS, MILLER & MOSHER L.L.P.  
1615 L Street, N.W., Suite 850  
Washington, D.C. 20036  
Telephone: (202) 785-0100  
Facsimile: (202) 408-5200

Date: JAN 4, 2007

I. REAL PARTY IN INTEREST

The real party in interest is the assignee of the inventors, Pergo (Europe) AB, a company of Sweden, having a principal address of Strandridaregatan 8, Trelleborg, Sweden S-231.

II. RELATED APPEALS AND INTERFERENCES

There are no related appeals or interferences known to Appellants, Appellants' legal representative or the assignee, which will directly affect, or be directly affected by, or have a bearing on, the Board's decision in the pending appeal.

III. STATUS OF CLAIMS

Claims 3-7, 9-15, 18-23 and 25 stand rejected. Claims 7 and 19 also stand objected to for formal matters. Claims 1, 2, 8, 16, 17, and 24 have been cancelled. Each of the objections and rejections are being appealed.

IV. STATUS OF AMENDMENTS

A first Amendment After Final was filed on July 11, 2006, which first amendment was not entered. A second Amendment After Final was filed on July 25, 2006, which second amendment was entered as indicated by the checking of box 7b on the Advisory Action of August 4, 2006.

V. SUMMARY OF CLAIMED SUBJECT MATTER

A. Independent Claim 7

Independent claim 7 recites a guiding means<sup>1</sup> at a joint between adjacent boards (Page 2, lines 21-22 and Figure 1 (one board being on the left of the figure and the adjacent board being on the right)). The boards include an upper surface and a core (Page 1, lines 6-8), and bounded by edges (Figures 1-4 (the outer peripheries of the boards)), at least one of said edges having a groove or tenon (Page 2, lines 21-22 and Figure 1 (elements 1 and 2)).

The groove or tenon has more than one guiding wedge, wherein the tenon has an angled distal surface and at least one of the guiding wedges is positioned between the angled distal surface and the core (Page 2, lines 21-31; and Figure 3 (the angled surface of elements 2, element 3)). A fitting clearance exists between the tenon of one board and a groove of the adjacent board (Page 2, line 29- Page 3, line 1). A first part of the fitting clearance is bounded by the distal end of the tenon and a proximal part of the groove (Figures 2 and 4 (elements 2, 3 and 4)), and a second, guiding, fitting clearance, is bounded by, on at least one side, at least one of the guiding wedges (Figures 3 and 4 (elements 2, 3 and 4)). The first and second fitting clearances are positioned so that the first fitting clearance is a main part of a fit of the joint and the second, guiding, fitting clearance comprises a smaller part of the fit (Page 3, lines 1-2). One guiding wedge includes a distal angled surface and a section extending from the distal angled surface of to the core, and the guiding wedges are arranged perpendicular to the extension of the joint (Page 3, lines 19-22; and Figure 3 (section of element 3 extending from the distal end of element 2)). Glue is applied during a manufacturing process of the boards (Page 3, lines 2-3 and original claim 2<sup>2</sup> (Page 4, lines 9-10)).

---

<sup>1</sup> Applicant respectfully notes that although the word “means” is used in the claims, none of the claims invoke the “means plus function” requirements of 35 USC § 112, sixth paragraph. Simply because the word “means” is recited does not invoke 35 USC § 112, sixth paragraph. See MPEP § 2181. Moreover, as “guiding means” is part of the preamble, and is not required to “breathe life and meaning” into the claims, the preamble language is not limiting.

<sup>2</sup> As the claims are part of the specification (“The specification shall *conclude with* one more claims ...” (35 USC § 112, emphasis added)), the originally filed claims are necessarily part of the application as filed. Since citation to the specification is required, citation to claims is proper.

B. Independent Claim 19

Independent claim 19 recites a surface made from multiple boards (Page 2, lines 21-22 and Figure 1 (one board being on the left of the figure and the adjacent board being on the right)). The first board has an upper surface and a core (Page 1, lines 6-8), and bounded by edges (Figures 1-4 (the peripheries of the boards), at least one of the edges having a groove (Page 2, lines 21-22). The second board also has an upper surface and a core (Page 1, lines 6-8), is bounded by edges, but at least one of the edges has a tenon (Page 2, lines 21-22 and Figure 1 (element 2)).

Either or both of the groove of the first board and the tenon of the second board has/have a guiding wedge, the guiding wedge including a distal angled surface and a section extending from the distal angled section to the core, and at least a second guiding wedge (Figure 3 (elements 2 and 3)). The guiding wedges are arranged perpendicular to the extension of a joint formed by the first and second boards (Page 3, lines 19-22; and Figure 3 (element 3)). Glue is applied during manufacture of the boards (Page 3, lines 2-3 and original claim 2<sup>3</sup> (Page 4, lines 9-10)).

C. Independent Claim 23

Claim 23 recites a process for forming a joint between adjacent boards. The boards include an upper surface and a core (Page 1, lines 6-8), and are bounded by edges (Figures 1-4 (the peripheries of the boards)). One of the edges includes a groove or tenon intended to be joined by means of glue applied during manufacture of said boards (Page 1, lines 2-3 and Page 3, lines 2-3). A fitting clearance is located between the tenon and the groove (Page 2, line 29- Page 3, line 1). The fitting clearance is formed by a first fitting clearance, bounded by a distal end of the tenon and a proximal part of the groove (Figure 3 (element 1)), and a second, guiding, fitting clearance, bounded by, on at least one side, a guiding wedge (Figures 3 and 4 (elements 2, 3 and 4)). The first fitting clearance comprises a main part of a fit of the joint and the second, guiding,

---

<sup>3</sup> Again, as the claims are part of the specification ("The specification shall *conclude with* one more claims ..." (35 USC § 112, emphasis added), the originally filed claims are necessarily part of the application as filed. Since citation to the specification is required, citation to claims is proper.

fitting clearance comprises a smaller part of the fit (Page 3, lines 1-2). The wedge includes a distal angled surface and a section extending from said distal angled section to the core, and the structure includes a second guiding wedge (Figure 3 (element 3)). The guiding wedges are arranged perpendicular to the extension of the joint (Page 3, lines 19-22; and Figure 3 (element 3)). In order to form the joint, adjacent boards are assembled.

VI. GROUND OF REJECTION TO BE REVIEWED ON APPEAL

- A. Claims 7 and 19 stand objected to for lack of antecedent basis.
- B. Claims 3-7, 9-15, 18-23 and 25 stand rejected under 35 USC § 103(a) as being unpatentable over Nelson (U.S. Patent No. 5,618,602) in view of WO 96/27721.

VII. ARGUMENT

- A. Because the Amendment After Final of July 25, 2006 was entered, the terms of claims 7 and 19 have proper antecedent basis.

In the final Office Action of April 25, 2006, the Examiner “objected” to claims 7 and 19 for having terms lacking proper antecedent basis, and suggested amendments which would apparently overcome the objections<sup>4</sup>. In response, Applicants amended each of claims 7 and 19 as recommended, i.e., to correct any lack of antecedent basis. However, in neither the Advisory Action of July 21, 2006 nor the Advisory Action of August 4, 2006 did the Examiner indicate that the objections have been overcome or withdrawn. Although the Notice of Non-Compliant Appeal Brief states, “it would *appear* that entry of the After Final amendment of July 25, 2006 overcomes the previously stated objections, rendering them moot, and therefore there is no longer any issue in this regard” (Page 2, emphasis added), Applicant has not been informed as to whether the amendments do, in fact, overcome the objections.

---

<sup>4</sup> As discussed herein, although called an “objection,” the issues identified with the claims are, in fact, a *rejection* under 35 USC § 112, second paragraph. Simply calling a rejection under 35 USC § 112, second paragraph, an “objection” does neither (1) make it so, nor (2) deprive the Board of Patent Appeals from its subject matter jurisdiction. Despite the mischaracterization of the action as an “objection,” the Board remains the sole adjudicator in the Patent Office to decide the propriety of this particular action (where claims were deemed unpatentable due to “lack of antecedent basis.”).

Applicants acknowledge that the proper vehicle to have “objections” reviewed is through a petition to the Commissioner, rather than through an appeal to the Board of Patent Appeals and Interferences. However, in this instance, as the “objection” is a veiled rejection under 35 USC § 112, second paragraph, Applicant respectfully submits that review of this “objection” is proper by the Board.

B. The Office Action has improperly shifted the burden of proof.

Upon examination, the burden lies with the Examiner to prove that each and every element recited by the claim is either found in a single prior art reference, or where a single reference does not teach each feature, that it would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the teachings of the reference to achieve the claimed invention. The Examiner must also identify a reason one of ordinary skill in the art would have been motivated to make the modification.

Through the numerous Office Actions, the Examiner has mischaracterized both Applicant’s statements, as well as the teachings of the cited reference in an apparent attempt to accuse the Applicant of having made admissions in order to shift the burden to the Applicant to show that the claims are patentable over the cited references.

C. The combination of the teachings of Nelson and WO ‘721 does not render the subject matter of claims 3-7, 9-15, 18-23 and 25 unpatentable.

Claims 3-7, 9-15, 18-23 and 25 stand rejected under 35 USC § 103(a) as allegedly being unpatentable over Nelson in view of WO 96/27721.

1. The cited references do not teach or suggest the guiding wedges as recited.

The present claims recite that the boards include guiding wedges which are arranged perpendicular to the joint formed by the boards. Despite the Examiner’s attempt to identify such a feature in the cited references, no such teaching can be found.

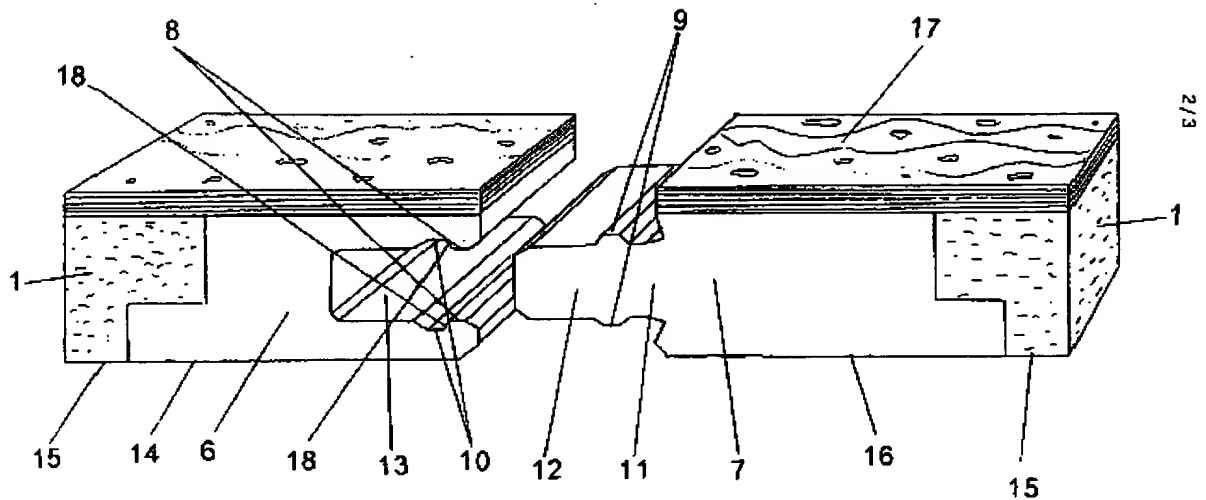
The final Office Action states, “Nelson fails to disclose that the at least one guiding wedge comprises a plurality of guiding wedges arranged perpendicular to the joint,” but asserts WO ‘721 “teaches, guiding wedges 9 arranged perpendicular to the joint.” However, the Office Action fails to explain the distinction between the structures of Nelson and WO ‘721.

The final Office actually states “The applicant argues that the Martensson *guiding wedges* (9) are arranged parallel to rather than perpendicular to the boards” (Page 8) (emphasis added). However, WO ‘721 does not include any structure identified as “guiding wedges,” as the elements identified with reference numeral 9 are “snapping webs.” Moreover, Applicant has not argued that WO ‘721 teaches guiding wedges 9 as quoted by the Examiner. The Examiner has mischaracterized the Applicant’s statement in an attempt to shoehorn his argument as an admission. At no time has the Applicant described the snapping webs 9 as being equivalent to the guiding wedges of the present claims. Moreover, the Examiner has not shown any “guiding wedges” in WO ‘721 and simply changing the name of snapping webs 9 does not make them so. Similarly, the Examiner also fails to mention any motivation that would have impelled one of ordinary skill to do what the Applicant has done.

Even if the snapping webs 9 of WO ‘721 were considered to be guiding wedges, the “guiding wedges” of WO ‘721, such “guiding wedges” do not include the other features recited by the claims. For example, the present claims recite that the guiding wedge includes “a section extending from said distal angled section to said core.” Because the snapping webs 9 of WO ‘721 are positioned, i.e., arranged, parallel to the extension of the joint between adjacent boards, such snapping webs 9 cannot have such a feature. Thus, the snapping web 9 of WO ‘721 cannot possibly be the equivalent of the presently claimed guiding wedge. There is neither a teaching nor suggestion in the cited art to perform such a modification.



**Fig. 2**



The present claims additionally recite that the guiding wedges are arranged perpendicular to the joint. As can be seen from Fig. 2 of WO '721 (reproduced immediately above), the snapping webs 9 extend (i.e., are arranged) in a direction *parallel* to the joint between the panels.

Thus, the snapping webs 9 of WO '721 cannot be "arranged" as presently claimed, i.e., "perpendicular" not parallel, and neither Nelson, nor WO '721 nor any other cited reference provides any teaching or suggestion whatsoever which would motivate one of ordinary skill in the art to modify the structure of Nelson to include the snapping webs 9 of WO '721, but only after having been rotated 90° so as to be arranged perpendicular to the joint.

Applicants note that the Office Action actually states "The applicant argues that the Martensson guiding wedges (9) are arranged parallel to rather than perpendicular to the *boards*" (Page 8) (emphasis added)<sup>5</sup>. Although Applicant explained, *more than once*, that this is a mischaracterization of both Applicant's arguments and the present claims in the previously filed

<sup>5</sup> As discussed above, Applicant does not admit now, nor has ever admitted, that the snapping webs 9 of WO '721 are "guiding wedges." as mistakenly asserted by the Office Action. Such lack of consideration for Applicant's arguments underscores the Examiner's failure to properly consider Applicant's remarks, and his blatant attempt to improperly shift his burden resulting from an alleged "admission" of the Applicant which never occurred.

amendment, and that the claims recite that guiding wedges are perpendicular to the *extension of the joint*, and not to the boards, such a distinction has been repeatedly ignored by the Examiner.

The final Office Action repeats, *verbatim*, the error from the Office Action of October 21, 2005. Thus, it appears the argument (including the footnote) on page 8 of the Amendment of February 21, 2006 was not considered, if not ignored.

The Advisory Action asserts that the language of the claims, i.e., “ wherein the guiding wedges are arranged perpendicular to the extension of the joint,” is met by guiding means wherein the guiding wedges are perpendicular to the *board*, because “the claim scope does not require interpretation any narrower than that applied in the previous Office Action final rejection.” Although Applicant repeatedly directed the Examiner’s attention to the clear and unambiguous language of the claims, reciting that the guiding wedges are “perpendicular *to the extension of the joint*” (emphasis added), i.e., not perpendicular to the board, such was apparently refused acknowledgment and consideration

The Advisory Action is correct that “the applicant’s argument that the limitation ‘perpendicular’ should be defined by the extension of the joint rather than the boards.”

This is supported by the literal language of the claims, and is not open to interpretation to the contrary with regard to this application.

Moreover, the Advisory Action continues, “Limitations cannot be read into the claims from the specification.” While Applicant agrees with this general statement, when examining claims, the Examiner is not free to interpret clear and unambiguous language of the claims by effectively eliminating features thereof in order to “shoehorn” the claim into an erroneous rejection. As far back as February 2003, the claims of this application have included the feature that “the guiding wedges are arranged perpendicular to the extension of the joint,” and neither the present Examiner nor his predecessor examiner, have cited a single reference teaching or suggesting to rotate the snapping webs 9 of WO ‘721 90°, such that they are *perpendicular to the extension of the joint*.

Although the Advisory Actions both apparently assert the remarks made in the Amendment After Final Rejection of July 25, 2006 argues features not recited by the claims, Applicant has repeatedly pointed out where the claims recite the features missing from the cited references. Thus, the final paragraphs provided on the “Continuation Sheets” attached to the Advisory Actions are, at best, incorrect “red herrings.”

As neither Nelson nor WO ‘721 teaches nor suggests to provide the guiding wedges as presently claimed, Applicant respectfully submits that no *prima facie* case of obviousness has been made.

2. The Office Action has not even attempted to identify a teaching or suggestion of glue applied during the manufacture of the panels.

The present claims recite a structural feature of glue having been applied during manufacture of the boards. Such a glue, or “preglue” as known in the art, is quite distinct from “fresh glue,” and is typically applied in a non-activated state, to be activated during the installation process. Fresh glue, on the other hand, is typically applied to the boards or panels in a fresh (usually liquid) state during the installation process. By utilizing a preglue, the glue can be previously applied during manufacture to simplify the process for the installer, as both the materials and steps necessary to complete the installation are minimized.

Despite this recitation, the final Office Action stated, the feature “during the manufacturing process of the boards” (last line of claim 7) has been given only “*limited* patentable weight” (emphasis added). However, as no attempt has been made by the Examiner to identify any teaching or suggestion whatsoever, Applicant can only assume that this structural feature has been given *no* patentable weight.

As none of the cited references teaches or suggests the inclusion of a glue applied during manufacture, Applicant respectfully submits the present claims are patentable over such references.

VIII. CONCLUSION

As the Examiner has failed to identify in the cited art each feature recited by the present claims, or in the alternative, establish why one of ordinary skill in the art would be motivated to modify the prior art, Appellant urges the Examiner committed reversible error in repeatedly rejecting the claims of this application as being unpatentable over the cited art.

APPENDICES

The following Appendices are attached to and made part of this brief:

Appendix A	Claims Appendix under 37 CFR § 41.37(c)(1)(viii)
Appendix B	Additional Evidence under 37 CFR § 41.37(c)(1)(ix)
Appendix C	Copies of Decisions under 37 CFR § 41.37(c)(1)(x)

Respectfully submitted,

Date: \_\_\_\_\_

TPP/EPR:mat

Attorney Docket No.: TPP30887CIP2

Thomas P. Pavelko

Registration No. 31,689

STEVENS DAVIS, MILLER & MOSHER L.L.P.

1615 L Street, N.W., Suite 850

Washington, D.C. 20036

Telephone: (202) 785-0100

Facsimile: (202) 408-5200

APPENDIX A

CLAIMS ON APPEAL

3. A process according to claim 23, wherein the glue is activated before joining the tenon with the groove.

4. The guiding means according to claim 7, wherein the first fitting clearance is in the range 0.1 - 1 mm, while the second, guiding, fitting clearance is in the range 0.01 - 0.2 mm.

5. The guiding means according to claim 7, wherein the first fitting clearance is in the range of 0.1 - 0.5 mm and the second fitting clearance is in the range of 0.02 - 0.1 mm.

6. The guiding means according to claim 7, wherein the first fitting clearance is in the range 0.1 - 0.5 mm, while the second, guiding, fitting clearance is in the range 0.01 - 0.1 mm.

7. A guiding means at a joint between adjacent boards, said boards comprising an upper surface, and a core, and bounded by edges, at least one of said edges comprising a groove or tenon, said groove or tenon comprising a plurality of guiding wedges, wherein the tenon has an angled distal surface and at least one of said guiding wedges is positioned between said angled distal surface and the core, wherein a fitting clearance between the tenon of a first of said boards and a groove of the adjacent board includes a first fitting clearance, the first fitting clearance being bounded by the distal end of the tenon and a proximal part of the groove, and a second, guiding, fitting clearance, which second, guiding, fitting clearance being bounded by, on at least one side, at least one of said plurality of guiding wedges, whereby the first fitting clearance comprises a main part of a fit of the joint and the second, guiding, fitting clearance comprises a smaller part of the fit, and said at least one of said plurality of guiding wedges comprises a distal angled surface and a section extending from said distal angled surface of said guiding wedge to said core, wherein the plurality of guiding wedges are arranged perpendicular to the extension of the joint, wherein glue is applied during a manufacturing process of the boards.

9. The guiding means according to claim 7, wherein the core of the boards is constituted by a fibre board or a particle board and that at least said upper surface of the board is constituted by a decorative thermosetting laminate.

10. The guiding means according to claim 23, wherein the core of the boards is constituted by a fibre board or a particle board and that at least said upper surface of the board is constituted by a decorative thermosetting laminate.

11. The guiding means according to claim 3, wherein the core of the boards is constituted by a fibre board or a particle board and that at least said upper surface of the board is constituted by a decorative thermosetting laminate.

12. (Previously Presented) The guiding means according to claim 4, wherein the core of the boards is constituted by a fibre board or a particle board and that at least said upper surface of the board is constituted by a decorative thermosetting laminate.

13. The guiding means according to claim 5, wherein the core of the boards is constituted by a fibre board or a particle board and that at least said upper surface of the board is constituted by a decorative thermosetting laminate.

14. The guiding means according to claim 6, wherein the core of the boards is constituted by a fibre board or a particle board and that at least said upper surface of the board is constituted by a decorative thermosetting laminate.

15. The guiding means according to claim 7, wherein the core of the boards is constituted by a fibre board or a particle board and that at least said upper surface of the board is constituted by a decorative thermosetting laminate.

18. The guiding means according to claim 7, wherein said guiding wedge consists of a distal angled surface and a section extending from said distal angled section to said core.

19. A surface comprising:  
a first board comprising an upper surface and a core, and bounded by edges, at least one of the edges comprising a groove; in combination with  
a second board comprising an upper surface and a core, and bounded by edges, at least one of the edges comprising a tenon;  
at least one of the groove of the first board and the tenon of the second board comprising a guiding wedge, the guiding wedge comprising a distal angled surface and a section extending from the distal angled section to the core, and at least a second guiding wedge, wherein the guiding wedges are arranged perpendicular to the extension of a joint formed by the first and second boards, and glue is applied during manufacture of the boards.

20. The surface of claim 19, wherein the combination of the first board and the second board defines at least one fitting clearance.

21. The surface of claim 20, further comprising glue, disposed inside the at least one fitting clearance.

22. The surface of claim 19, wherein said glue is disposed between the groove of the first board and the tenon of the second board.

23. A process for forming a joint between adjacent boards, said boards comprising an upper surface and a core, and bounded by edges, at least one of said edges comprising a groove or tenon intended to be joined by means of glue applied during manufacture of said boards, wherein a fitting clearance between the tenon and the groove includes a first fitting clearance, the first fitting clearance being bounded by a distal end of the tenon and a proximal part of the groove, and a second, guiding, fitting clearance, which second, guiding, fitting clearance being

bounded by, on at least one side, a guiding wedge, whereby the first fitting clearance comprises a main part of a fit of the joint and the second, guiding, fitting clearance comprises a smaller part of the fit, said guiding wedge comprises a distal angled surface and a section extending from said distal angled section to said core, and further comprising at least a second guiding wedge, wherein the guiding wedges are arranged perpendicular to the extension of the joint, said process comprising assembling the adjacent boards to form said joint.

25. The process of claim 23, wherein said glue is applied to said at least one edge.



APPENDIX B: Evidence Appendix under 37 CFR § 41.37(c)(1)(ix)

N/A

APPENDIX C: Related Proceedings Appendix under 37 CFR § 41.37(c)(1)(x)

N/A